

ATTORNEY DOCKET NO.: 0492611-0315 (MIT 6196)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Griffith-Cima, et al.	Examiner:	D. Naff
Serial No.:	09/008,945	Art Unit:	1651
Filed:	January 20, 1998		
For:	TISSUE FORMATION BY INJECTING A CELL-POLYMERIC SOLUTION THAT GELS IN VIVO		

Commissioner of Patents
Washington, DC 20231

Sir:

DECLARATION UNDER 37 C.F.R. 1.132

We, Anthony Atala, Linda G. Griffith, Charles A. Vacanti, and Keith T. Paige declare as follows:

1. We are the inventors of the subject matter disclosed and claimed in United States patent application Serial No.09/008,945 ('945 application) filed January 20, 1998 and entitled "TISSUE FORMATION BY INJECTING A CELL-POLYMERIC SOLUTION THAT GELS IN VIVO". This application claims priority to United States patent application Serial No. 08/056,140 now issued U.S. Patent No. 5,709,854, by Griffith-Cima et al. entitled "Tissue Formation by Injecting a Cell-Polymeric Solution that Gels In Vivo", filed on April 30, 1993.

2. This Declaration is presented for the purpose of removing from consideration by the Examiner an abstract by Atala et al., entitled "Cartilage Cells as a Potential Treatment for Reflux", American Academy of Pediatrics, 1992 Annual Meeting, Section on Urology Program for Scientific Sessions, San Francisco, CA, Saturday, October 10-12, (1992) (Reference "R"). The conference began on October 10, 1992, at which time the above-referenced abstract was

available to the public in this country. The present Declaration is presented in accordance with *Ex Parte Magner*, 133 USPQ 404 (CCPA 1961) and *In re Katz*, 455,215 USPQ 14, 18 (CCPA1982) and establishes that the allegedly anticipatory material in Reference R was not invented by another.

3. Charles Vacanti and Anthony Atala are two of the inventors on the instant application and are also two of the co-authors of Reference R.

4. Alan B. Retik is the third co-author of Reference R. Dr. Retik is not an inventor of the claimed invention and did not make an inventive contribution to the subject matter of Reference R. Dr. Retik was working under the direction of Dr. Atala when he participated in the research which was described in Reference R.

5. Linda G. Griffith, Charles A. Vacanti, Keith T. Paige, and Anthony Atala mutually conceived and reduced to practice the invention recited in the claims of the '945 application. Dr. Griffith has changed her name from Griffith-Cima since the parent application was filed.

6. All statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patents issued thereon.

Anthony Atala, M.D.

Date

Linda Griffith, Ph.D.

Date

Charles A. Vacanti, M.D.

Date

Keith T. Paige, M.D.

Date

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rejection of the appealed claims as indefinite and failing to point out the invention.

[4] The lengthy petition, in effect, merely expresses disagreement with our view that in the particular circumstances of this case the examiner was correct in holding that the product should be defined by the process of making it. We have carefully considered the petition but are not persuaded thereby that our decision is in error. In respect to the patents which petitioners call to our attention, we point out that what was done during the prosecution of other applications for patent is not controlling here.

The petition has been considered but is denied in respect to making any change in our decision.

Particular patents—Preparing Uranous Tetrafluoride
8,080,175, Magner, Long, Ellis, and Grinstead, Preparation of High Purity UF₄, claim 18 of application allowed.

Appeal from Division 46.

Application for patent of James E. Magner, Ray S. Long, David A. Ellis, and Robert R. Grinstead, Serial No. 676,604, filed July 31, 1957. From decision rejecting claim 18, applicants appeal. Reversed.

ROLAND A. ANDERSON, Germantown, Md., for appellants.

Before AGG, Examiner in Chief, and BREKENS and GASTON, Acting Examiners in Chief.

GASTON, Acting Examiner in Chief.

This is an appeal from the final rejection of claim 18 the only claim in the case.

Claim 18 is as follows:

18. In a process for preparing highly pure uranous tetrafluoride from impure uranium laden solvent extraction process strip solutions and ion exchange process and resin-in-pulp process eluate solutions which are at least 8M in hydrochloric acid, the steps comprising treating said solution with a reducing agent thereby reducing the uranium in said solution to the +4 oxidation state, contacting the solution with an extractant phase comprising about 10 to 70% of tributyl phosphate in an organic solvent-diluent selected from the group consisting of benzene, ethyl-benzene, chlorobenzene, toluene, xylene, kerosene, and carbon tetrachloride to extract the uranium therein, treating the extract phase with an aqueous fluoride solution to precipitate uranous tetrafluoride therefrom, and separating the uranous tetrafluoride from the phases."

The reference relied on is:

AEC Document DOW-147, Sept. 1, 1956, pp. 8-11

Appellants' process and that of the reference are sufficiently described in appellants' brief and the Examiner's Answer.

Claim 18 stands rejected by the examiner as unpatentable over the DOW-147 publication.

[1] The sole issue in this case is the procedure necessary for removing as a reference DOW-147, a publication by three of the four inventors of this application, published less than a year before the application filing date.

Patent Office Board of Appeals

Ex parte MAGNER, LONG, ELLIS, AND GRinstead

Patent issued Apr. 17, 1962

Opinion dated Oct. 25, 1961

PATENTS

1. Affidavits — Anticipating references (§ 12.3)

Interference — Originality of invention — In general (§ 41.561)

Patentability — Anticipation — Publications — In general (§ 51.2271)

Publication by three of four inventors of instant application, published less than a year before application filing date, is removed as reference by such three inventors' affidavit wherein they state that they are authors of publication, that they are three of four co-inventors of invention claimed in application, that fourth coinventor and themselves mutually participated in conception, research, and reduction to practice of claimed invention, and that publication was prepared from research records of themselves and fourth coinventor; explanatory affidavit by fourth coinventor is unnecessary; affidavit under Rule 181 is unnecessary since no question of priority is involved; affidavit sufficiently explains relation of publication to application; any competent evidence convincing to Patent Office may be accepted on question of originality.

The three co-authors of the publication, constituting three of the four joint inventors, have filed an affidavit which states that they are the authors of DOW-147 and are three of the four co-inventors of the invention claimed in this application. The fourth co-inventor and themselves mutually participated in the conception, research and reduction to practice of the invention claimed in this case, and the portion of DOW-147 pertaining to the claimed invention was prepared from the research records of themselves and the fourth co-inventor. Appellants urge that this affidavit is sufficient to remove DOW-147 as a reference as to the appealed claim.

Among other decisions, appellants rely on Ex parte Layne, 68 USPQ 17. There the applicant presented an affidavit stating that the operation described in a publication by another was the actual operation conducted by the applicant and that the publication was made with applicants' consent.

The examiner's holding is that appellants have no affidavit under Rule 181 and have not followed the procedure of Ex parte Layne, supra, in that no explanatory affidavit by the fourth joint inventor has been presented.

The article is by three of the four joint inventors; we see no necessity for an affidavit under Rule 181 as no question of priority is involved. The question is as to attribution of inventorship— an explanation of the relation of the publication by three of the joint inventors to the application of all four of them. We think that the affidavit satisfies this requirement. On the question of originality any competent evidence convincing to the Office may be accepted. There is no reason to doubt the statement of the three joint inventors as to the participation of the fourth inventor as this statement is of no benefit to them.

The decision of the examiner is reversed.

Patent Office Trademark Trial and Appeal Board

AMERICAN BEAUTY PLEAT, INC.
JUDKINS COMPANY; JUDKINS COMPANY v. AMERICAN BEAUTY PLEAT, INC.

Decided Mar. 6, 1962

TRADEMARKS

1. Identity and similarity — Word Similar (§ 67.4117)

"Glamor Fold" so resembles "Beauty Fold" as to be likely to cause confusion in trade.

2. Identity and similarity — How determined — In general (§ 67.4051)

Differences between decalcomania labels on which parties apply in marks are immaterial and irrelevant to determination of applicant's right to register its mark.

3. Cancellation — In general (§ 67.171) & Cancellation — Abandoned mark (§ 173)

Since opposer's use of its registered mark was prior to applicant's use of mark, and since confusion is likely: it is clear that applicant, at time of filing of petition to cancel opposer's mark, did not possess any right in its mark which it could assert against opposer; accordingly, opposer's registration is not inconsistent with right which applicant may have in mark; hence, question whether registered mark has been abandoned can be of no concern to applicant.

4. Abandonment — In general (§ 67.0) Assignor of trademark was used mark prior to and at time of assignment; fact that assignor's sales of the mark at that time were small does not constitute an abandonment of mark; although assignee never sold or acted article upon which assignor's mark, it has used mark since assignment on goods intended for similar use which could originate from same source as assignor's goods; thus, assignment of mark cannot constitute abandonment by it of registered mark.

Trademark opposition No. 39,718 American Beauty Pleat, Inc., against Judkins Company, application, Serial No. 82,238, filed Sept. 28, 1959. Opposition sustained. Trademark cancellation No. 7,467 Judkins Company against American

Joseph F. Nakamura and Gerald H. Bjork for Patent and Trademark Office.
Markey, Chief Judge, and Rich, Baldwin Miller, and Nies, Associate Judges.
Nies, Judge.

tors merely from fact of co-authorship; on other hand, when PTO is aware of printed publication that describes subject matter of claimed invention and is published before application is filed (only date of invention on which it must act in absence of other proof), article may or may not raise substantial question whether applicant is inventor; for example, if author, whether he is applicant or not, specifically states that he is describing applicant's work, no question at all is raised; content and nature of printed publication, as well as circumstances surrounding its publication, not merely its authorship, must be considered.

8. Patentability — Anticipation — Publications — In general (§51.2211)

Although submission of disclaiming affidavits or declarations by other authors of article that does not tell anything specific about inventorship and that reports on scientific work in which applicant and other authors have been engaged in some capacity would have ended inquiry into whether it can be reasonably concluded that applicant is sole inventor, they are not required by statute or Rule 132, what is required is reasonable showing supporting basis for applicant's position.

9. Applicants for patent — In general (§14.1)

Patentability — Anticipation — Publications — In general (§51.2211)

Joint inventorship cannot be inferred, in face of sworn statements to contrary, from article authored by applicant and students working under applicant's direction and supervision.

Particular patents — Immunological Tolerance Induction

Katz, Induction of Immunological Tolerance, rejection of claims 1, 5, 17, and 19 reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of David Harvey Katz, Serial No. 937,574, division of application, Serial No. 764,586, filed Feb. 3, 1977. From decision rejecting claims 1, 5, 17, and 19, applicant appeals. Reversed; Miller, Judge, dissenting with opinion.

John H. Lynn and Grant L. Hubbard, both of New York, N.Y., for appellants.

right; no barrier is created by that section unless another has either actually reduced invention to practice or has constructively reduced it to practice by filing patent application.

3. Interference — Priority (§41.70)

Interference — Reduction to practice — Constructive reduction (§41.755)

Unlike filing of patent application, publication of article is not constructive reduction to practice of subject matter described in it; therefore, disclosure in publication does not prove that any "invention" within meaning of Section 102(g) has ever been made by anyone.

4. Patentability — Anticipation — Patents — In general (§51.2211)

Patentability — Anticipation — Publications — In general (§51.2271)

Interpretation of Section 102(a) that would make prior patent or printed publication "prior art" even though disclosure is that of applicant's own work would negate one year period afforded under Section 102(b) during which inventor is allowed to perfect, develop, and apply for patent on his invention and publish descriptions of it if he wishes.

5. Patentability — Anticipation — In general (§51.201)

One's own work is not prior art under Section 102(a) even though it has been disclosed to public in manner or form that otherwise would fall under Section 102(a); disclosure to public of one's own work constitutes bar to grant of patent claiming subject matter so disclosed, or subject matter obvious from it, only when disclosure occurred more than one year prior to application's date, that is, when disclosure creates one-year time bar, to application under Section 102(b); one's own invention, whatever form of disclosure to public, may not be prior art against oneself, absent statutory bar.

6. Patentability — Anticipation — Publications — In general (§51.2211)

Disclosure of publication that occurred less than one year before applicant's application comes within scope of Section 102(a) only if description is not of applicant's own work.

7. Patentability — Anticipation — Publications — In general (§51.2211)

Authorship of article by itself does not raise presumption of inventorship with respect to subject matter disclosed in article; thus, co-

efficient; Lindstrom v. Ames, 37 App. D.C. 35, 1911 C.D. 384 (1911) (proof of actual reduction to practice negates having to rely on one's filing date for constructive reduction to practice). See also Starr v. Farmer, 1883 D. 34, 23 O.G. 2325 (Sec'y Int. 1883), wherein it was held that actual reduction to practice may be better evidence of invention than an application but that "until that evidence [the application] is overthrown," id. at 1, the applicant need do more than rely on his application filing date.

In any event, I would remand for determination of Daugherty's right to rely on the date of their application as their priority date for a determination of priority based on the evidence of Daugherty's actual reduction to practice.

Court of Customs and Patent Appeals

In re Katz

No. 82-521

Decided Aug. 27, 1982

ATTENTS

Court of Customs and Patent Appeals — Issues determined — Ex parte patent cases (§28.203)

CCPA treats Section 102(g) rejection that Board of Appeals did not specifically reverse as having been affirmed.

Interference — Priority (§41.70)

Section 102(g) embodies principle that to be entitled to patent one must be first to have made invention; however, prior conception of invention by another does not defeat one's

As noted in *Tafe v. Winchell*, supra at 61, 209 USPQ at 382 n. 10, only abandonment, suppression or concealment of the invention are grounds under §102(g) for awarding priority de jure to the party who is not the first inventor de facto. Thus, I disapprove of the view expressed by the Board in *Isagado v. Pelzer*, 212 USPQ 838, 845 (BOP 1981) (on Petition for Rehearing) that a party to an interference who has not complied with the "best mode" requirement of the statute has "no right to make" his claims corresponding to the counts and, therefore, is not entitled to an award of priority, irrespective of testimony as to inventive acts.

This appeal is from the decision of the Patent and Trademark Office (PTO) Board of Appeals (board) sustaining rejection of claims 1, 5, 17, and 19, all remaining claims in application Serial No. 937,574 for "Induction of Immunological Tolerance." The subject application is a divisional application of application Serial No. 764,586, filed February 3, 1977, and is entitled to that filing date. The claims were rejected because of a description of the subject matter of the invention in a publication dated June 1976, which appellant, however, asserts is a description of his own work. The board was unpersuaded by appellant's declarations to the effect and sustained the rejection. We reverse.

Background

In June, 1976, eight months before appellant's effective filing date, an article coauthored by Nicholas Chiorazzi, Zelig Eshter, and appellant was published in the Proceedings of the National Academy of Sciences U.S.A., Vol. 73, No. 6, pp. 2091-95. There is no dispute that the article (Chiorazzi et al., fully describes the claimed invention.

Along with his divisional application, appellant filed a declaration in which he declared that:

He is the sole inventor of the subject matter described and claimed in the United States Patent Application Serial No. 764,586, filed February 3, 1977, entitled, "INDUCTION OF IMMUNOLOGICAL TOLERANCE," which subject matter is disclosed and claimed in part in the divisional application with which this declaration is submitted.

He is co-author of a report in the proceedings of the National Academy of Sciences, U.S.A., Volume 73, No. 6, Page 2091-2095, June, 1976, communicated to the National Academy of Science by Albert H. Coons, a member of said Academy, on March 8, 1976, that he is the sole inventor of the subject matter which is disclosed in said publication in the proceedings of the National Academy of Science and disclosed and claimed in the application submitted

[6] Since the publication in this case occurred less than one year before appellant's application, the disclosure comes within the scope of §102(a) only if the description is not of appellant's own work.

The specific question present in this appeal is essentially an evidentiary one, namely, the sufficiency of appellant's showing to establish that the subject disclosure was his original work, and his alone. We conclude that appellant's declaration is sufficient in this case to overcome the rejection.

[7] As an initial matter, we hold that authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter disclosed in the article. Thus, co-authors may not be presumed to be inventors merely from the fact of co-authorship. On the other hand, when the PTO is aware of a printed publication, which describes the subject matter of the claimed invention and is published before an application is filed (the only date of invention on which it must act in the absence of other proof), the article may or may not raise a substantial question whether the applicant is the inventor. For example, if the author (whether he is the applicant or not) specifically states that he is describing the work of the applicant, no question at all is raised. The content and nature of the printed publication, as well as the circumstances surrounding its publication, not merely its authorship, must be considered.

What we have in this case is ambiguity created by the printed publication. The article does not tell us anything specific about inventorship, and appellant is only one of three authors who are reporting on scientific work in which they have all been engaged in some capacity at the Harvard Medical School. It was incumbent, therefore, on appellant to provide a satisfactory showing which would lead to a reasonable conclusion that he is the sole inventor.

Such showing can be made under Rule 132, 37 CFR 1.132, which provides:

When any claim of an application is rejected on reference to a *** printed publication *** affidavits or declarations traversing [the reference] *** may be received.

The solicitor notes that in the application, there is an inconsistency in that the subject application and its parent by a sole inventor refer to previous work done by "one of the inventors." While adding to the ambiguity, this statement, which appellant's attorney represents was his error in draftsman-

ship. This inference is sufficient to justify a determination by the PTO that the reference printed publication ("Chiorazzi et al.") in question is prior art under 35 USC 102 as applied against an application for patent filed by one of the coauthors. In re Facius, 56 CCPA 1348, 408 F.2d 1396, 161 USPQ 294 (1969); In re Mathews, 56 CCPA 1033, 408 F.2d 1393, 161 USPQ 276 (1969); In re Land, 54 CCPA 806, 368 F.2d 866, 151 USPQ 621 (1966). Although all of the latter opinions by this court have involved prior patents issued to different inventive entities, the board has established a line of cases involving only printed publications. In re Magner, 133 USPQ 404 (1961); In re Seaborg, 131 USPQ 202 (1960); In re Hirschler, 110 USPQ 384 (1952); In re Layne, 63 USPQ 17 (1943). Such cases are analogous to the instant appeal, and, contrary to appellant's arguments, are consistent.

In Layne, the board agreed with the examiner that an affidavit by the applicant, stating that an article published by another was made with the applicant's consent, was not sufficient to overcome the examiner's rejection. The board stated:

[I]t is stated in the brief that counsel can obtain an affidavit of the writer of the article in the publication that he obtained his information from the deponent. It is our view that this affidavit of the writer of the article, H. Lee Flood, should be furnished to afford complete and satisfactory proof of the identity of the article disclosed in the publication.

*** Until the affidavit referred to is furnished, the rejection on the publication in the Petroleum Engineer appears proper.

As argued by the Solicitor, this printed publication is also evidence that "the invention was known or used by others in this country *** or described in a printed publication in this *** country, before the invention thereof by applicant" under 35 USC 102(a) and, as held by the examiner, is evidence that "before the applicant's invention thereof the invention was made in this country by another" under 35 USC 102(g). The "others" in 102(a), "not himself" in 102(f) and "another" in 102(g) are terms that serve to distinguish between different inventive entities. Contrary to the majority opinion's view of section 102(g), the Katz et al. article indicates that the invention was actually reduced to practice; appellant did not contest the examiner's rejection on this basis. In this case, Katz, the applicant, is one inventive entity and his effective date of invention, as the record now stands, is his application filing date. Collectively, Katz, Chiorazzi, and Esbhar comprise a second inventive entity. See

For this reason, the rejection is affirmed. It is recommended, however, that if a printed affidavit of H. Lee Flood is promptly submitted, the claims be allowed.

63 USPQ at 19. Layne differs from the present case in that the inventor in Layne was not named as a coauthor; here, Katz was one of the named coauthors.

When presented with an examiner's rejection utilizing a publication authored by applicant and his laboratory assistant, board in Hirschler refused to sustain a rejection in view of the submission of affidavit disclaiming inventorship which executed by the lab assistant. The board

[A]n affidavit which points out that applicant took no part in writing the article and that the inventor of the subject matter is described in the article, but was merely a coauthor of the article in order to receive credit for having collaborated on the research program under the directions of the applicant, is properly acceptable *** the article may be considered the work of present applicant. Since the affidavit is not a statutory bar, it is not effective reference.

110 USPQ at 387. Here, of course, there is no disclaiming affidavits filed by the coauthors and alleged noninventors.

Appellant quotes the following statement from the board in Seaborg explaining that a Rule 131 affidavit was unnecessary:

The issue is not one of priority but attribution of inventorship, the examiner evident having in mind the possibility that Wahl might be a joint inventor. But we would emphasize that the bare fact that Wahl the literary co-author is not evidence of joint inventorship.

131 USPQ at 203. This statement is 149 out of context, the board actually concluding

On the question of originality any evidence convincing to the Office may be accepted. The evidence here is in the form of an affidavit by joint author Wahl stating that he is not the inventor of the subject matter claimed herein. In absence of a showing of interest there seems to be no basis for challenging this affidavit. In the examiner's statement on page 4 of his answer that he "has no doubt that Seaborg is a sole inventor of the subject matter"